

REMARKS

Claims 1, 13, and 23 are amended to recite that patient specific data for the selected patient and medication specific data for the selected medication is printed on the pair of peel-off labels. Claims 3-5, and 15 are previously canceled. Claims 28 and 29 are added. Thus, claims 1, 2, 6-14, and 16-29 are pending and at issue in this application.

Applicant respectfully traverses the rejection of claims 1-7, 13-16, 23, and 24 as obvious over Tung et al. (U.S. Patent No. 5,803,498), Yuyama et al. (U.S. Patent No. 5,839,836) and Alexander et al. (6,179,202). Each of the pending claims recites printing patient specific data and medication specific data on a first section of a sheet where the first section also includes a pair of peel-off labels. As acknowledged by the office action, neither Tung et al. nor Yuyama et al. recite a pair of peel-off labels disposed on a single section. Instead, the office action relies on Alexander et al. to remedy the deficiency. However, while Alexander et al. recites a pair of peel-off labels disposed on a single section, Alexander et al. fails to disclose patient specific data and medication specific data printed on the same section, and fails to provide any motivation or suggestion to combine or modify its label to do so. Specifically, Alexander et al. discloses a certified mailing label that is unrelated to any pharmacy application and fails to recognize any need to provide patient and/or medication related information on the section of its label containing the peel-off labels. In fact, providing patient or medication specific data may violate patient disclosure laws when placed on a mailing label. Also, while the office action identifies a single common element among references (i.e., printing), a common element alone is not a proper motivation to combine or modify.

Furthermore, the office action fails to make a prima facie case of obviousness because the asserted combination fails to teach all the elements recited in claims 1-7, 13-16, 23, and 24. Specifically, the office action asserts a motivation for combining only two of the claimed elements and improperly extends this motivation to the remaining elements:

...the motivation for doing so would be to have a printing apparatus that allows medication instructional sentences or the like to be printed in detail an in [sic] appropriate expressions responsive to differences among disease names, drugs, and patients, as divulged by Yuyama in Col. 1, lines 35-40, and to have the printer having an input arranged to receive the sheet, the printer further arranged to print on both faces of the sheet as divulged in Col. 1 lines 29-31 by Alexander et al.

Essentially, the Office action asserts a motivation for combining duplex printing with printing medication sentences. However, this motivation fails to address other elements of the claims, such as the pair of peel-off labels disposed on a single section, where the single section contains patient specific data and medication specific data. As discussed above, none of the references provide a motivation for a single label section having patient specific data, medication specific data, and two peel-off labels. It follows that the office action fails to make a prima facie case of obviousness and that no combination of Tung et al., Yuyama et al. nor Alexander et al. can render the pending claims obvious.

Notwithstanding the remarks above, and to expedite the allowance of the pending claims, Applicant has amended claims 1-7, 13-16, 23, and 24 to recite that patient specific data for the selected patient and medication specific data for the selected medication is printed on the pair of peel-off labels of the first area of the sheet. This amendment is supported by Figure 1. As discussed in the previous office action, the obverse face of the sheet has a first and second area and the sheet is adapted to fold along a plurality of fold lines, where the first and second area of the obverse face are disposed on the same section. This amendment serves to clarify that patient specific data and medication specific data are printed on the pair of peel-off labels which are disposed on the single section (as defined by folds lines). None of the references discloses a pair of peel-off labels disposed on a single section having patient specific data and medication specific data printed thereon, and therefore, no combination of Tung et al., Yuyama et al., and Alexander et al. can render the pending claims obvious.

Applicant respectfully traverses the rejection of claims 10 and 19 as obvious over the combination of Tung et al., Yuyama et al., and Griffiths et al. in further view of Bellesfield et al. (U.S. Patent No. 6,282,489). Claims 10 and 19 recite a database including location-specific data associated with a selected medication for a plurality of store locations, and a controller arranged to forward the location-specific data associated with the selected medication to a printer for printing the sheet. The office action states that:

“It is old and well known in the art that location specific data associated with a selected medicine can be stored with in [sic] a database. A pharmacy, hospital, drug store etc. (i.e. place of interest) name and location can be stored in the database as taught by Alexander et al. in Col. 3 lines 25-34. This would allow a user to look up a specific pharmacy associated with the medicine of interest in order to fill a prescription, pick up medicine etc. Therefore the deficiencies of claims 10 and 19 in which Bellesfield et al. represent stand rejected under Bellesfield et al.”

However, the claims recite not only location specific data, but location specific data associated with a selected medicine that is stored in a database and printed on a sheet. Alexander et al at Col. 3, lines 25-34 discloses printing a return address postcard, which has no relation to any medication, hospital, drug store or pharmacy related application, and thus, fails to disclose location specific data associated with a selected medicine. It is improper for the Office to simply cite references that disclose a portion of an element and then assert that the entire element is taught. See MPEP § 2143.03 (To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. . . . **all words in a claim must be considered** in judging the patentability of that claim against the prior art. [Emphasis added])

Moreover, the office action asserts an improper motivation to combine by stating that the location specific data disclosed by Alexander “would allow a user to loop up a specific pharmacy associated with the medicine of interest in order to fill a prescription, pick up medicine etc.” The office action provides no support in any of the cited references for this motivation. In fact, this motivation is only found in the Applicant’s disclosure. (See page 6, lines 17-21; page 8, lines 21-22; page 10, lines 1-3) This is impermissible hindsight according to MPEP § 2142 (“The tendency to resort to ‘hindsight’ based upon applicant’s disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.”). Therefore, the motivation to combine or modify is improper and cannot support the obviousness rejection.

Furthermore, because the assertion that “it is old and well known in the art that location specific data associated with a selected medicine can be stored with in [sic] a database,” is unsupported by any of the references, Applicant can only assume that the Examiner is taking official notice with this statement, as defined by MPEP 2144.03(A). If this is the case, then Applicant hereby challenges that it is not common knowledge to store location specific data associated with a selected medicine for printing on a pharmacy label and respectfully requests that the Examiner provide documentary evidence to support the official notice. As discussed in the previous office action, the medicine related, location specific data may be, for example, information concerning where in a store the selected medication is located, or information concerning the source of the prescription or delivery of

the prescription. This medicine related, location specific data is bundled and supplied with other data on a pharmacy label in the claimed manner to, for example, provide convenience and efficiency to a pharmacy store. Existing systems of providing pharmacy information do not appear to incorporate medicine related location data, and thus, Applicant submits that this data is not commonly known in the art. Applicant reminds the Examiner that if the Examiner is relying on personal knowledge to support the finding of what is known in the art, the Examiner must provide an affidavit or declaration setting forth specific factual statements and an explanation to support the finding. MPEP § 2142.03(C).

To further clarify the location-specific medication data recited in claims 10 and 19, claims 28 and 29 are added. Claims 28 and 29, depending from claims 10 and 19 respectively, recite that the location-specific data includes a location within a pharmacy store in which the selected medication is located. None of the references discloses or teaches location specific medicine data, much less location specific medicine data pertaining to a location within a pharmacy store in which the selected medication is located. Therefore, claims 28 and 29 are allowable over the cited references.

Applicant respectfully traverses the rejection of claims 9, 11, 12, 18, 20, 21, 26, and 27 as obvious over any combination of Tung et al., Yuyama et al., Alexander et al., Lourette et al., McJohnson, and Whitehouse. As discussed above, none of Tung et al., Yuyama et al., Alexander et al. disclose or teach a pair of peel-off labels disposed on a single section having patient specific data and medication specific data printed thereon. None of Lourette et al., McJohnson, or Whitehouse discloses or teaches a pair of peel-off labels disposed on a single section having patient specific data and medication specific data printed thereon, nor is Lourette et al., McJohnson, or Whitehouse cited for this purpose. It follows that none of the cited references can render the pending claims obvious.

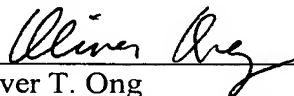
CONCLUSION

Applicant submits that this case is in a condition for immediate allowance. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests reconsideration and allowance of rejected claims 1, -2, 6-14, 16-27 and new claims 28-29.

If there are matters that can be discussed by telephone to further the prosecution of this application, Applicants respectfully request that the Examiner call its attorney at the number listed below.

Respectfully submitted,

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September 25, 2006